

Express Mail Label No.  
EV416449637US



FSUM 10551.1  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Robert A. Holton et al.  
Serial No. 09/978,436  
Filed October 16, 2001  
Confirmation No: 5339  
For RADIOSENSITIZING TAXANES AND THEIR  
PHARMACEUTICAL PREPARATIONS  
Examiner Ba K. Trinh

Art Unit 1625

April 2, 2004

LETTER TO THE PATENT OFFICE

TO THE ASSISTANT COMMISSIONER FOR PATENTS,  
SIR:

This letter is in response to the Office action dated December 2, 2003, the time for response to which is extended to April 2, 2004 under 37 C.F.R. §1.136(a).

Reconsideration is requested of the rejection of claims 4-8 and 10-17 as anticipated by structure II in figure 1 of Tao et al. (U.S. Patent No. 5,780,653), and the objection to claim 9 as being dependent on a rejected base claim. On May 1, 2003 a Section 131 affidavit and experimental evidence was submitted to the Office showing that Holton et al. completed and reduced to practice the subject matter of this application in the United States before June 7, 1995, the filing date of U.S. Patent No. 5,780,653. This affidavit has been identified by the Office as Document #16; upon request, another copy can be submitted.

Based on the May 1, 2003 submission of said Section 131 affidavit, the office allowed claims 1-17 on June 17, 2003. In the interest of complete disclosure, applicants submitted the Federal Circuit's decision in The Board of Education v. American Bioscience, Inc., No. 02-1109 (Fed. Cir. June 23, 2003) along with a Request for Continued Examination, dated September 17, 2003. The issue decided by the Federal Circuit was inventorship. The issue raised in the present Office Action, and the Office Action dated November 1, 2002, however, is whether the Tao et al. patent (regardless of inventorship) may properly be cited against the claims of the present

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application under 35 U.S.C. 102(e). For the reasons already stated of record, Holton et al. completed and reduced to practice the subject matter claimed herein before the filing date of the application which matured into the Tao et al. patent. Accordingly, a rejection under § 102(e) of claims 4-8 and 10-17 cannot be properly maintained notwithstanding the Federal Circuit's holding concerning inventorship.

Claim 9 is patentable for the reasons stated above with respect to claims 4-8 and 10-17.

Applicants submit that the present application is in condition for allowance and requests allowance of the pending claims.

Applicants request a one (1) month extension of time to and including April 2, 2004 for filing a response to the above-mentioned Office action. A check for \$110.00 in payment of the applicable extension fee is enclosed.

The Commissioner is requested to charge any fee deficiency or overpayment in connection with this amendment to Deposit Account 19-1345.

Respectfully submitted,



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FEE TRANSMITTAL

Application Number 09/978,436  
Filing Date October 16, 2001  
Confirmation No. 5339  
Inventor(s) Robert A. Holton et al.  
Group Art Unit 1625  
Examiner Name Ba K. Trinh  
Attorney Docket Number FSUM 10551.1

**METHOD OF PAYMENT**

1.  The Commissioner is hereby authorized to charge the indicated fees to Deposit Account No. 19-1345.
- The Commissioner is hereby authorized to charge any additional fees required under 37 CFR 1.16 and 1.17 to Deposit Account No. 19-1345.
- Applicant claims small entity status.

2.  Check Enclosed. The Commissioner is hereby authorized to charge any under payment or credit any over payment to Deposit Account No. 19-1345.

**FEE CALCULATION**

1.  BASIC FILING FEE Subtotal (1) \$ \_\_\_\_\_  
(Type: \_\_\_\_\_)

2.  EXTRA CLAIM FEES Subtotal (2) \$ \_\_\_\_\_

Total Claims \_\_\_\_\_  
Independent Claims \_\_\_\_\_  
Multiple Dependent Claims \_\_\_\_\_

3.  ADDITIONAL FEES Subtotal (3) \$ 110.00

- Surcharge - late filing fee or oath
- Surcharge - late provisional filing fee or cover sheet
- Extension for reply within 1st month
- Notice of Appeal
- Filing a Brief in Support of an appeal
- Request for ex parte Reexamination
- Petitions to the Commissioner
- Submission of Information Disclosure Statement
- Recording each patent assignment per property
- Request for Continued Examination
- Other: \_\_\_\_\_

**TOTAL AMOUNT OF PAYMENT \$ 110.00**

Edward J. Hejrek, Reg. No. 31 525

Date

EJH/dep

4/2/04